

### **REMARKS**

Applicant appreciates the Examiner's thorough consideration provided the present application. Claims 1-13, 44-47, 49 and 50 are now present in the application. The abstract and claims 1-13 and 44-47 have been amended. Claims 49 and 50 have been added. Claims 14-43 and 48 have been withdrawn and hereby cancelled. Claims 1 and 44 are independent. Reconsideration of this application, as amended, is respectfully requested.

### **Interview With The Examiner**

A telephone interview was conducted with the Examiner in charge of the above-identified application on May 26, 2010. Applicant greatly appreciates the courtesy shown by the Examiner during the interview.

During the interview, the Examiner confirmed that the Caparso reference mentioned in the outstanding Office Action is U.S. Patent Application Publication No. 2010/0016927.

### **Priority Under 35 U.S.C. §119**

The Examiner did **not** acknowledge Applicant's claim for foreign priority under 35 U.S.C. §119. Acknowledgement thereof in the next Office Action is respectfully requested.

### **Information Disclosure Citation**

Applicant thanks the Examiner for considering the references supplied with the Information Disclosure Statements filed on February 1, 2007 and January 29, 2009, and for providing Applicant with an initialed copy of the PTO/SB/08 forms filed therewith.

### **Drawings**

The Examiner did not indicate whether or not the formal drawings have been accepted. Since no objection has been received, Applicant assumes that the drawings are acceptable and

that no further action is necessary. Confirmation thereof in the next Office Action is respectfully requested.

### **Specification Objections**

The abstract stands objected to due to the presence of minor informalities. In view of the foregoing amendments, it is respectfully submitted that this objection has been addressed. Accordingly, Applicant respectfully submits that this objection has been obviated and/or rendered moot. Reconsideration and withdrawal of this objection are respectfully requested.

### **Claim Objections**

Claims 11-13 and 47 stand objected to under 37 C.F.R. 1.75(c). In view of the foregoing amendments, it is respectfully submitted that this objection has been addressed. Accordingly, Applicant respectfully submits that this objection has been obviated and/or rendered moot. Reconsideration and withdrawal of this objection are respectfully requested.

### **Claim Rejections Under 35 U.S.C. §112**

Claims 1-10 and 44-46 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Claims 1-10 and 44-46 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. These rejections are respectfully traversed.

In view of the foregoing amendments, it is respectfully submitted that these rejections have been addressed. In particular, claims 1 and 44 have been made to further recite “comparing a value of the measured applied stimulation in one of the one or more sympathetic tone-dependent points with a value of the measured applied stimulation in one of the one or more sympathetic tone-neutral points so as to determine the sympathetic tone.” Therefore, claims 1 and 44 clearly recite that the determination of the sympathetic tone has been done by comparing the values of the measured applied stimulation in a sympathetic tone-dependent point and a

sympathetic tone-neutral point. Accordingly, all pending claims comply with the enablement requirement and are definite and clear. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first and second paragraphs, are therefore respectfully requested.

### **Claim Rejections Under 35 U.S.C. § 102**

Claims 1-5, 10 and 44 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Tuckett, U.S. Patent No. 5,381,805, as evidenced by Caparso, U.S. Patent Application Publication No. 2010/0016927. Claims 1, 8-10 and 44 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Barsa, U.S. Patent No. 4,570,640. Claims 1, 4-7, 10 and 44-46 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Mauderli, U.S. Patent Application Publication No. 2003/0105412. These rejections are respectfully traversed.

Complete discussions of the Examiner's rejections are set forth in the Office Action, and are not being repeated here.

In light of the foregoing amendments, Applicant respectfully submits that these rejections have been obviated and/or rendered moot. Without conceding to the propriety of the Examiner's rejections, but merely to timely advance the prosecution of the application, as the Examiner will note, independent claims 1 and 44 have been amended to recite a combination of steps including "measuring an applied stimulation at a threshold value of the stimulation in one or more sympathetic tone-neutral points; measuring an applied stimulation at the same threshold value in one or more sympathetic tone-dependent points; and comparing a value of the measured applied stimulation in one of the one or more sympathetic tone-dependent points with a value of the measured applied stimulation in one of the one or more sympathetic tone-neutral points so as to determine the sympathetic tone."

Support for the amendments to claims 1 and 44 can be found on page 12, line 24 – page 13, line 21 and page 17, line 4 – page 18, line 26 of the specification as originally filed. Applicant respectfully submits that the combination of steps set forth in claims 1 and 44 is not disclosed or suggested by the references relied on by the Examiner.

Tuckett in col. 4, lines 29-36 discloses tests employing stimulation on several points including the median nerve in the carpal tunnel area (referred to by the Examiner as the sympathetic tone-dependent point). However, Tuckett nowhere discloses *comparing* the value of the measured applied stimulation in the median nerve with the value of the measured applied stimulation in a sympathetic tone-neutral point to determine the sympathetic tone. Therefore, Tuckett fails to teach “comparing a value of the measured applied stimulation in one of the one or more sympathetic tone-dependent points with a value of the measured applied stimulation in one of the one or more sympathetic tone-neutral points so as to determine the sympathetic tone” as recited in claims 1 and 44.

Although the Examiner alleged that Barsa discloses applying a stimulation to the spiral cord containing sympathetic and non-sympathetic nerves, Barsa nowhere discloses *comparing* the value of the measured applied stimulation in a sympathetic nerve with the value of the measured applied stimulation in a sympathetic tone-neutral nerve to determine the sympathetic tone. Therefore, Barsa fails to teach “comparing a value of the measured applied stimulation in one of the one or more sympathetic tone-dependent points with a value of the measured applied stimulation in one of the one or more sympathetic tone-neutral points so as to determine the sympathetic tone” as recited in claims 1 and 44.

Mauderli in paragraph [0021] and [0025] discloses an apparatus to produce a painful/non-painful condition in a chamber where a test animal is located by using one or more thermoelectric modules. However, Mauderli nowhere discloses *comparing* the value of the measured applied stimulation in a painful condition with the value of the measured applied stimulation in a non-painful condition to determine the sympathetic tone. Therefore, Mauderli fails to teach “comparing a value of the measured applied stimulation in one of the one or more sympathetic tone-dependent points with a value of the measured applied stimulation in one of the one or more sympathetic tone-neutral points so as to determine the sympathetic tone” as recited in claims 1 and 44.

Since Tuckett, Barsa and Mauderli fail to teach each and every recitation of amended independent claims 1 and 44, Applicant respectfully submits that amended independent claims 1 and 44 are not anticipated by any of Tuckett, Barsa and Mauderli.

In addition, claims 2-10 and 45-47 depend, either directly or indirectly, from independent claims 1 and 44, and are therefore allowable based on their respective dependence from independent claims 1 and 44, which are believed to be allowable.

In view of the above, Applicant respectfully submits that claims 1-10 and 44-47 clearly define the present invention over the references relied on by the Examiner. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are respectfully requested.

#### **Claim Rejections Under Obviousness-type Double Patenting**

Claims 1-10 and 44-46 provisionally stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 123-134 of co-pending Application No. 12/440,438. Claims 1-10 and 44-46 provisionally stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of co-pending Application No. 11/885,486. These rejections are respectfully traversed.

Applicant respectfully submits that because the claims in the '438 Application and the '486 Application have not been indicated as being allowable, no further comment or action is necessary at this time.

It is also noted that the present application was filed **prior to** the '438 Application and the '486 Application. Therefore, once the present application is in condition for allowance except for the obviousness-type double patenting rejection, this application should be allowed without the necessity of filing a Terminal Disclaimer (see MPEP 804(I)(B)(1)).

### **Additional Claims**

Claims 49 and 50 have been added for the Examiner's consideration. Applicant respectfully submits that claims 49 and 50 are allowable due to their respective dependence on independent claim 1, as well as due to the additional recitations included in these claims. Favorable consideration and allowance of claims 49-50 are respectfully requested.

### **CONCLUSION**

All the stated grounds of rejection have been properly traversed and/or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently pending rejections and that they be withdrawn.

It is believed that a full and complete response has been made to the Office Action, and that as such, the Examiner is respectfully requested to send the application to Issue.

In the event there are any matters remaining in this application, the Examiner is invited to contact Cheng-Kang (Greg) Hsu, Registration No. 61,007 at (703) 205-8000 in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: June 16, 2010

Respectfully submitted,

By 

Paul C. Lewis

Registration No.: 43368

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road, Suite 100 East

P.O. Box 747

Falls Church, VA 22040-0747

703-205-8000

